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Remarks

Claims 1-53 are pending in the application. All claims stand rejected. By this paper, claims 1, 7, 6, 8, 23, 25, and 27 have been amended. Claims 2-5, 9, and 12 have been canceled. Reconsideration of all pending claims herein is respectfully requested.

Claims 1-53 were rejected under 35 U.S.C. 103(a) as being unpatentable over Terakado et al. ("Terakado") in view of Elliott et al. ("Elliott"). This rejection is respectfully traversed.

As amended, claim 1 recites a remote control device for a digital video recorder, comprising:

a wireless receiver for receiving a **play list from the digital video recorder**; the play list comprising television programs previously recorded by the digital video recorder;

an integrated display screen for displaying the **play list** to a user;

a plurality of user controls for controlling the digital video recorder, at least one user control for receiving a selection of a television program from the **play list displayed on the integrated display screen**; and

a wireless transmitter for transmitting an indication of the selected television program to the digital video recorder to initiate **playback** of the selected television program.

The combination of Terakado and Elliott could not be more different from the claimed invention. First, Terakado does not display anything remotely similar to a "play list ... comprising television programs previously recorded" on the integrated display of the remote control. At best, Terakado displays broadcast schedule information, also referred to as an electronic program guide or "EPG."

According to Terakado, "[r]adio waves transmitted from the antenna of a broadcasting station are received by the antenna of a television receiver. The television receiver extracts an EPG from the received radio waves and transmits it to a remote controller.... The remote controller displays the received EPG on an LCD .... If some program is selected ... the remote controller transmits a control command for a recording reservation to a video tape recorder." Abstract (emphasis added).

Thus, Terakado's EPG is merely a broadcast schedule. The broadcasting station and the television receiver have no way of knowing what programs have been recorded by the video tape recorder (VTR). Hence, Terakado's EPG cannot have anything to do with "previously recorded" television programs, as claimed.

Second, Terakado's remote control does not wirelessly receive television program information from a recording device. The only communication discussed in Terakado is unidirectional -- the remote sends channel, date, and time information to the VTR to schedule a recording. By contrast, all of the independent claims, including claim 1, as amended, recite the concept of transmitting information from the recording device to the remote control for display on the integrated LCD.

While Terakado does refer to "an infrared transmission/reception section 14" of the VTR, this is just another name (and probably a literal translation from Japanese) for an infrared "transceiver." While it is possible to have separate transmission and reception components, it is more common to have the components combined in a single device for manufacturing convenience. However, this does not imply that part 14 of Terakado is being used to transmit information to the remote

control. Even if it was used for transmission, there is no teaching or suggestion that the transceiver is used to transmit program guide information, much less a list of recorded programs. By contrast, part 10 of Terakado's television set is used to transmit EPG information to the remote control. Terakado, col. 5, lines 50-53.

In fact, Terakado teaches the exact opposite of transmitting program data from the VTR to the remote control. When a user makes a selection of a program displayed by the remote control, the remote control sends schedule information (date, time, channel) to the VTR to schedule a recording. If Terakado's VTR already had the schedule information for a program (in order to be able to transmit it to the remote control, as claimed), there would be no need to transmit the date, time, and channel of a selection to the VTR. This would be completely redundant.

Furthermore, unlike the claimed invention, Terakado requires a special television receiver. Conventionally, TVs are simply monitors. They have nothing to do with recording programs. Terakado requires intelligence in the TV to extract EPG data from the radio waves and transmit the EPG to the remote control. By contrast, the claimed invention transmits schedule information and play lists from the DVR to the remote control.

The addition of Elliott does not supply the missing element of transmitting a play list from a recording device to a remote control. While it is true that Elliott discloses a standard digital video recorder (DVR), Elliott does not transmit any information from the DVR to a remote control. While standard DVRs include something like the claimed play lists, they are universally displayed on the main

television screen, contrary to the principles of the claimed invention, since they interfere with television viewing.

A reference disclosing merely the existence of an EPG on a remote control does not suggest or render obvious the display of other types of information on the remote control, no matter how unusual such a display would be. The Applicants respectfully submit that no remote control to date has displayed a play list of recorded programs from a DVR on a secondary screen integrated with the remote control. No one using a remote control would expect to see such a display. The only way a person of ordinary skill in the art, with access to Terakado, would think to display a play list on a remote control would be if they also had the present application as a roadmap.

To further illustrate this point, a side-by-side comparison of Terakado and Elliott is instructive.

Terakado

Elliott

No play lists

Play list on main TV screen only

Remote receives EPG from TV, not VTR

No transmission from DVR to remote

Remote must send time/channel data to VTR to schedule recording

A person of ordinary skill in the art would not be able to combine Elliott with Terakado without hindsight reconstruction based on the Applicants' own teachings. To display a play list on a remote control would require communication of the play list from the recording device to the remote control. Since neither of the references teach this, the Applicants respectfully submit that the Office Action is impermissibly relying on the Applicants' own teachings. See *In re Dembiczak*, 175 F.3d 994, 999

(Fed. Cir. 1999) (holding the Board impermissibly used hindsight in determining obviousness).

A rejection based on prior art — whether grounded in anticipation or obviousness — must account for each and every claim limitation. *Celeritas Techs. Inc. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998) (anticipation); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q.2d 494, 496 (CCPA 1970) (obviousness); MPEP § 2143.03 ("To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.") (emphasis added). In this case, the cited references are clearly deficient in that (1) there is no teaching or suggestion of displaying a play list on an integrated display of a remote control, and (2) there is no teaching or suggestion of a remote control wirelessly receiving a play list from a DVR or other recording device. Applicants respectfully request that the obviousness rejection be withdrawn.

Independent claim 14 recites "a digital video recorder comprising: a wireless transmitter for transmitting a list of television programs to a remote control device." The Office Action points to items 10 and 14 of Figs. 1, 5, and 6 of Terakado for this limitation. However, item 10 is not a component of the recording device (VTR 13), but, rather, of the television receiver 9. As argued above, item 14 is merely a infrared transceiver, which includes combined reception/transmission capabilities for manufacturing convenience. However, there is no teaching or suggestion of actually transmitting EPG data, much less a play list from the VTR to the remote control in a way that would enable a person of ordinary skill in the art to make and use the

invention. Simply mentioning a transceiver would not enable a claim to transmission of a particular type data. Therefore, the passing reference to a transceiver in Keratado's VTR, which is described only in the context of receiving programming commands from the remote control, does not render obvious the claimed invention.

Independent claims 33, 40, 52, and 53 recite that the digital video recorder transmits a list of programs to the remote control. For example, independent claim 33 recites a method "in a remote control device" including the step of "receiving a list of television programs from the digital video recorder." As argued above, there is no teaching or suggestion of transmitting a list of television programs (either representing live broadcasts or previously recorded programs) from the DVR (or VTR) to the remote control.

In view of the foregoing, the applicants respectfully submit that all pending claims, as amended, are patentably distinct over the cited references, alone or in combination. Early allowance of all pending claims herein is respectfully requested.

Respectfully submitted,

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